

REMARKS**Examiner Interviews**

Applicant thanks Examiners Bates and Examiner Najjar for participating in the Examiner Interview on October 30, 2006. During that meeting, the basis for the rejection of the claims, and the distinctions between the claimed invention and the cited art was discussed. The discussion focused primarily on how the auxiliary receiver(s) of Robbins performs a scanning step. Although the auxiliary receiver of Robbins can save ID codes in a memory, the auxiliary receiver(s) *does not selectively store* ID codes. That functionality is attributed to the main receiver alone, which in turn does not perform a scanning step.

Without acquiescing to the propriety of the rejections, applicant agreed to clarify the independent claims to more explicitly set forth the features of the claimed invention, wherein the need for any auxiliary receiver is eliminated and yet its function is retained. Additionally, and as explained further below, in response to a comment made by Examiner Bates during the interview, applicant has also clarified the independent claims to convey that the user is alerted to a channel other than the channel that the user is currently listening to.

Specifically, the Examiner indicated that if the claims were amended to recite that the "scanning runs in the background" while audio is being provided to a user, the claims would be distinguished from the cited art. This point was clarified for applicant during the interview dated December 8, 2006.

At the Examiner's request during the October interview, applicant also discussed the terms "designations" and "works of authorship."

Applicant also thanks the Examiner for removing the finality of the previous office action.

Amendment to the Specification

Applicant has amended the specification to include a description of the drawings. Withdrawal of the objection is respectfully requested.

Appln. Serial No.: 09/922,487

Claim Rejections Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 41-43, 45, 47, 48, 50-53, 55-56, 58, 61-64, 74-77 and 81 stand finally rejected under 35 U.S.C. § 103 as unpatentable over Robbins, U.S. Patent No. 6,317,882, in view of Titlebaum et al., U.S. Patent No. 6,549,774, in further view of Owens et al., U.S. Patent No. 6,067,278 for the reasons set forth on pages 3 through 15 of the Final Office Action.

Claims 46 and 57 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown. and Owens et al., in further view of Barton, U.S. Patent No. 6,233,389. Claims 49, 59, 79, and 80 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown and Owens et al., in further view of Wall, U.S. Patent No. 6,055,244.

Applicant respectfully submits that the Office's continued inclusion of the previously overcome Brown reference is merely a carry-over from the earlier rejection and is in error. Fortunately, because the base claims from which claims 46, 49, 57 59, 79 and 80 depend are allowable for all the reasons set forth below, these claims are also allowable and the improper bases for the rejections recited in the Office Action are moot.

For at least the following reasons, applicant respectfully submits that the claims are patentable in view of the art of record. First, the combination of references fails to at least suggest, much less disclose, each and every claim limitation of the independent claims and the claimed invention provides novel and nonobvious solutions to technological problems, including how to find works of authorship playing on channels or stations other than the one the user is currently listening to, in a mobile satellite audio radio context by including information that can be used to identify user desired content.

1. The Combination of References Does Not Disclose, Teach, or Suggest All of the Claim Limitations

For a finding of obviousness, it is well established that the prior art reference (or references when combined) must teach or suggest all the claim limitations, see, e.g., MPEP § 2142. Here the claims recite features that are absent from the references, as described further below.

1A. The Claimed Invention Recites Novel and Non-Obvious Features

MPEP § 1242 requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, there must be a reasonable expectation of success of arriving at the claimed invention.

Accordingly, for the following reasons, the rejections under § 103 should be withdrawn because the cited art, alone or in combination, does not satisfy MPEP § 1242, much less 35 U.S.C. § 103.

1A(i). The Claims Provide Indicia of Unobviousness

Applicant respectfully submits that the claims provide indicia of unobviousness. Specifically, according to MPEP 2144.04(II)(B), the omission of an element and retention of its function is indicia of unobviousness. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

The Office Action, at page 18, recites that Robbins teaches at least one auxiliary receiver which monitors data streams so that there is at least one receiver, namely an auxiliary receiver, that monitors channels and thus the claims are obvious. However, and as explained further below, the reasoning of the Office is deficient in that it fails to take into consideration the actual limitations of the claims.

Specifically, and contrary to the position taken by the Office, applicant respectfully submits that because the claims recite scanning for a user designated work of authorship on "a" mobile satellite audio radio receiver, the claims as previously examined are patentable in view of the cited art because Robbins, or a combination of Robbins with any of the cited references, fail to teach the claimed limitations of, generally, *selectively saving* a designation of a work of authorship on a single receiver *and* scanning for designations and comparing the saved designation with designations provided on a channel or channels in the absence of auxiliary receivers.

Based on the discussion during the interview on October 30, 2006, applicant agreed to clarify the independent claims to explicitly recite a single receiver for

Appln. Serial No.: 09/922,487

receiving, selectively storing and scanning for designations of works of authorship, wherein the user is alerted to change to a channel other than the channel that the user is currently listening to when a match occurs. Support for the clarifications can be found in at least paragraphs 18, 70 and 71 of the specification as originally filed.

Although applicant submits that the amendment addresses Examiner Bates' concern about "running in the background," based on the additional discussion held on December 8, 2006, applicant has further clarified the claims to recite that the comparison between (a) one or more designation that are selectively saved in a memory; and, (b) a designation that is provided by satellite radio, occurs while the receiver is providing audio to the user.

As explained during the December 8, 2006 interview, support for this amendment can be found in at least paragraphs 18, 70, 71, and the prophetic example set forth in paragraph 88. For example paragraph 18, which relates to a satellite radio embodiment, recites: "*the software initiates commands to alert the User such that the User can select to listen to or view the song(s) or video(s) by changing the current station to the appropriate station and then optionally record the song or video*" (emphasis added). Clearly, the claimed embodiments require that the user is listening to a current station while the software initiates commands in the background. Thus, the claims fully address Examiner Bates's concerns and are patentable over the cited art. Notwithstanding the foregoing, the claims are also patentable for the following reasons.

Specifically, Robbins (and therefore the alleged hypothetical combination of Robbins, Titlebaum et al. and Owens et al.) requires a system which includes two or more receivers, namely one main receiver and one or more auxiliary receivers; to accomplish what applicant has done with just one satellite audio radio receiver. More particularly, Robbins' main receiver (e.g., receiver 804) provides content to the user and stores ID codes (which according to the Office are the same as "user designations of works of authorship") based on user selection.

However, the main receiver does not scan for ID codes - only the auxiliary receivers scan. Again, contrary to the position taken by the Office at page 18 of the Office Action, Robbins requires a main receiver in combination with one or more auxiliary receivers to selectively save an ID code and scan.

Appln. Serial No.: 09/922,487

Although Robbins indicates that the auxiliary receiver may automatically store ID codes (e.g., designations) in a memory (see, e.g., col. 40, lines 50-59), such storage is not accomplished by user selection, as explained at col. 40, lines 48-59. Further, these stored ID codes are for purposes other than for comparison to user selected ID codes. For example, the auxiliary receiver of Robbins stores ID codes for prioritization, as described at column 39, lines 30 to 42.

Applicant respectfully points out that the disclosure of Robbins is replete with instructions for using auxiliary and main receivers in combination and this requirement is apparent throughout the teaching of Robbins.

For the following reasons, applicant also respectfully submits that the teachings of Robbins provide that only the main receiver stores in a memory ID codes based on user selection and only auxiliary receivers scan for ID codes for comparison to the selectively saved ID code(s). For example, col. 11, lines 10-31, and in particular lines 25-31, col. 11, lines 47-53, and col. 24, lines 19-34, describe how to achieve the foregoing embodiments and objectives of Robbins using auxiliary receivers. Furthermore, the description of Fig. 1 of Robbins indicates that auxiliary receivers are used (see, e.g., col. 31, lines 62-67 (one auxiliary receiver) and col. 33, lines 24-37 (a plurality of auxiliary receivers)). Moreover, the written description of Fig. 5(A) denotes that the figure includes auxiliary receivers, see col. 32, lines 1-22. Other indicia of the requirement of one or more auxiliary receivers are apparent throughout the teaching of Robbins, as described hereafter.

Applicant respectfully points to Figs. 10(A) and 10(B), and the description thereof at col. 42, lines 19-53 of Robbins, which also outlines the requirement of auxiliary receivers in a system of receivers. Applicant also respectfully points out that all of the independent claims of Robbins also require auxiliary receivers.

Furthermore, the last paragraph before the "Exemplary Embodiment," sets forth these requirements by reciting the following at col. 40, lines 1-6:

"The following exemplary embodiment, includes a receiving system having a plurality of auxiliary receiver, each for scanning a plurality of data streams in an interlaced fashion. One of skill in the art, after reading the present disclosure, would know how to

implement the remaining embodiments as described above in light of the following embodiment.” (emphasis added)

Thus, applicant respectfully submits that the above described paragraph factually proves that all of the preceding embodiments described in Robbins require one or more auxiliary receivers, consistent with all of the cited paragraphs above and the description of the exemplary embodiment, as detailed hereafter.

Robbins’ exemplary embodiment itself, the description of which starts at col. 40, line 9, and which particularly references Figs. 8(A) and 8(B), explicitly requires a main receiver (804) and one or more auxiliary receivers (806).

The exemplary embodiment also provides insight as to the interaction that is required between the one or more auxiliary receivers and the main receiver, and the functions of each in the system of Robbins. Specifically, and as described at col. 40, lines 25-41, the main receiver 804 stores an ID code and only the auxiliary receiver(s) scan the spectrum of data streams for ID codes and sends the ID codes to comparator unit 808.

Thus, Robbins requires communication between a main receiver and one or more auxiliary receivers via a comparator. Moreover, Robbins does not teach or suggest that the auxiliary receiver selectively stores ID codes based on a user selection. Nor does Robbins teach or suggest that the main receiver scans.

Contrast the preceding with the stand-alone devices and methods of applicant’s claimed invention. Here, applicant’s claimed invention clearly omits key features of Robbins, namely the requirement of at least one auxiliary receiver, yet retains the scanning function of the omitted element and also obtains, at least, the advantages described in the application. Thusly, the claims are unobvious over the cited art.

Additionally, applicant respectfully submits that because Robbins uses auxiliary receivers that are distinct from the main receiver, the auxiliary receivers may cause an alert to be provided to a user even when the user is listening to the channel to which the user is alerted by the auxiliary receivers (see, e.g., col. 34, line 41 through col. 35, line 29 of Robbins). Thus, to further clarify the claimed invention, and distinguish it

Appln. Serial No.: 09/922,487

from the cited art, applicant has also claimed that the invention alerts the user to a channel/station that is other than the channel/station that the user is currently listening to.

Accordingly, because applicant's claimed invention scans one or more satellite audio radio channels or stations for information (e.g., designations) and compares the information to designations of works of authorship selectively saved in a memory by a user (i.e., a user designation), in the absence of an auxiliary receiver and where the step of comparing designations occurs while the receiver is providing audio to the user, when a match is found the invention alerts a user to a channel/station other than the channel/station that the user is listening to, under the rules set forth in the MPEP § 2144, the claimed invention is unobvious because, generally, Robbins' feature of one or more auxiliary receivers that scan for ID codes is omitted, while applicant's invention retains that features function.

1A(ii) Robbins Explicitly Teaches Away From the Claimed Invention

Following the teachings of Robbins which is directed to *a system* of a main receiver and at least one auxiliary receiver, one of skill in the art would not have been motivated to integrate the auxiliary and main receivers together, nor would one such skilled have considered the system of a main receiver and auxiliary receiver (e.g., the receiving *system 802*, detailed at column 40 of Robbins) as a single receiver, much less arrive at the claimed invention with any expectation of success, as explained below. This is because Robbins perceives a need for and indeed discloses a requirement that at least one auxiliary receiver is necessary for, at least, scanning for ID codes. Yet Robbins also indicates that a plurality of auxiliary receivers is preferable to one. At col. 33, lines 24-37, Robbins recites:

“Another exemplary embodiment of a device used for the scanning step (S114) as described in FIG. 1, of an embodiment of the present invention, may include a plurality of auxiliary receivers to scan the data stream spectrum. This may increase the price of the system over that of one auxiliary receiver, however, the response time in which the system may automatically tune to a specific data stream may be decreased over that of one auxiliary receiver, since the total amount of time T spent detecting all the data streams

Appln. Serial No.: 09/922,487

would be divided by the number of auxiliary receivers. Therefore, the number of auxiliary receivers will proportionately decrease the amount of time needed to detect and compare a particular data stream." (emphasis added)

As noted above, the invention of Robbins recognizes the advantages of a plurality of auxiliary receivers to proportionately decrease the amount of time needed to detect and compare a particular data stream relative to the time required for one auxiliary receiver, i.e. more is better.

Even in an embodiment where only one frequency is scanned in a terrestrial radio environment, Robbins still requires auxiliary receivers, see, e.g. col. 35, lines 49-54, which states that there may be a decrease in the *needed* auxiliary receivers. Applicant submits that by referring to the "needed auxiliary receivers," Robbins evidences the factual requirement of at least one auxiliary receiver being present in combination with a main receiver in order for Robbins' invention to function.

To one of skill in the art, the language of Robbins that is set forth above teaches away from eliminating auxiliary receivers or considering an auxiliary receiver alone in a vacuum or even considering the combination of a main receiver and auxiliary receiver(s) as a single receiver because (1) the use of a plurality of auxiliary receivers is explicitly stated as providing superior results relative to a single auxiliary receiver, (2) Robbins requires at least one auxiliary receiver *in combination with* a main receiver to function, (3) Robbins does not disclose that the objectives of the invention can be met, even in an inferior manner, in the absence of auxiliary receivers, and (4) Robbins does not consider the system of receivers as a single "receiver."

Accordingly, under the teachings of Robbins, it is disadvantageous to eliminate all of the auxiliary receivers or use an auxiliary receiver alone in a vacuum to then allegedly arrive at the claimed invention. Therefore, the disclosure of Robbins factually discredits and discourages the solution claimed by applicant.

1A(iii.) There is No Expectation of Success and the Proposed Modification Renders Robbins Non-Functional

Moreover, even if combined or modified in the manner suggested by the Office, one of skill in the art would still not arrive at the claimed invention because the

Appln. Serial No.: 09/922,487

alleged and hypothetical combination would require a main satellite audio radio receiver and one or more auxiliary satellite audio radio receivers each in communication with the main receiver via a comparator, which is far different from applicants claimed invention, particularly when one properly considers the claimed invention as a whole. Thus, one of skill in the art would have no expectation of success at arriving at the claimed invention.

According to the conjecture of the Office on page 18 of the Office Action, Robbins teaches a single auxiliary receiver that meets the limitations of the claims. However, and as described herein such modifications render Robbins unsatisfactory for its intended purpose and destroys its intended function.

This is because, at least, (1) the auxiliary receivers scan, (2) there is no teaching that main receiver scans, and (3) applicant respectfully submits that without auxiliary receivers, no scanning would occur because one or more auxiliary receivers are required to be used in combination with a main receiver in a system for scanning data streams. Thus, there is no suggestion or motivation to make the proposed modification to arrive at the claimed invention because in the absence of one or more auxiliary receivers, no scanning would occur thereby rendering Robbins non-functional. Alternatively, in the absence of a main receiver, as suggested by the Office on page 18 of the Office Action, there would be nothing selectively saved in a memory to which to compare the ID codes from the auxiliary receiver(s), thereby again rendering Robbins non-functional. See, e.g., *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Based on the above, it is clear that the inventor of the present invention showed insight that was contrary to the expectations of the art, which is itself indicia of unobviousness. See, e.g., MPEP 2145(X)(D) and *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Accordingly, applicant respectfully requests withdrawal of the rejection.

1B. The Office Provides No Objective Evidence or Reason of Obviousness And Thus Has Not Established A Prima Facie Case

In the present case, the Office has (1) not specified the skill level of one of one of ordinary skill in the art, and (2) does not provide any objective evidence from Robbins, Titlebaum et al. or Owens et al., much less the prior art as a whole or even generally available knowledge (other than what has been gleaned from applicant's own

Appln. Serial No.: 09/922,487

disclosure, as described in more detail below) to suggest the desirability, and thus the obviousness, of making the combination, assuming for the sake of argument that such a combination even results in the claimed invention.

In fact, to date the Office has failed to resolve the factors under 35 U.S.C. §103 in light of *Graham v. John Deere Co.* 383 U.S. 1 (1966), because the Office has yet to define the level of ordinary skill in the pertinent art. Additionally, and as set forth above, in its attempts to determine the scope of the art and ascertain the differences between the art and claims at issue, the Office has yet to provide any objective, cogent line of reasoning for arriving at the conclusion that the claimed invention is obvious. Rather, the Office continues to merely rely on conjecture and supposition in support of the rejections.

As the Office is aware, a mere statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). For this reason, applicant also submits that claims 43 and 52 are separately patentable as these claims recite a specific time frame for searching that is unobvious in view of the art. However, applicant submits that even in the absence of the claimed time limitations, these claims are patentable for at least all of the reasons set forth herein.

Although applicant submits that the claims recite features that are not "old" as described above in Part 1A, even if the features were to be considered "old" the combination would still be patentable. This is because the Federal Circuit has created a mandatory presumption, even in the PTO, that combinations of "old" elements are patentable. As applicant stated during the Examiner Interview on October 30, the presumption is in favor of the applicant, and can be overcome by the PTO only with "evidence" and "specific findings" of motivation or suggestion to combine. The evidence must be detailed. See, e.g., *In re Lee* (Fed. Cir. 2002).

Appln. Serial No.: 09/922,487

Accordingly, based on the teachings of the references, there is no such relevant evidence as a reasonable mind might accept as adequate to support the conclusion of obviousness of the claims. Also, there is no substantial evidence to extrapolate the teaching to modify Robbins in any manner to arrive at the claimed invention. Therefore the rejection under 35 U.S.C. § 103 is improper and applicant respectfully requests that the rejection be withdrawn with respect to independent claims 41, 43, 52, 61, 74, 75 and 76, as well as the claims dependent thereon.

2. The Office Has Fallen Into the Hindsight Trap

As the court noted in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness” (quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998)).

Applicant respectfully submits that “our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Dembiczak*, 175 F.3d at 999. This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability- the essence of hindsight.” *Id.*

Although the MPEP at § 2145 indicates that “[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning,” here it is clear that the Office has once again engaged in *impermissible* hindsight. This is because in the absence of applicant’s disclosure, a person of ordinary skill in the art would have had no motivation to combine the prior art teachings, much less have had motivation to combine the prior art teachings in the particular manner claimed for all the reasons described hereinabove. Here, the motivation to combine does not come from any of the references, but rather from the Office alone.

Appln. Serial No.: 09/922,487

3. Summary

In summary, Robbins, Titlebaum et al. and Owens et al., are all deficient in that none suggest, much less disclose, the claimed invention *as a whole* and that (i) even if the references were to be combined, one skilled in the art would still not arrive at the claimed invention, as described in Part 1 and because Robbins requires one or more auxiliary receivers and in the absence of a main receiver in combination with an auxiliary receiver(s), Robbins cannot compare a work of authorship that is currently playing with a user designated work of authorship, (i.a.) Robbins teaches away from the claimed invention, and (i.b.) the Office has failed to show any objective evidence supporting the combination.

Therefore the rejection under 35 U.S.C. § 103 is improper and applicant respectfully requests that the rejection be withdrawn with respect to independent claims 41, 43, 52, 61, 74, 75 and 76.

Lastly, because claim 42 depends upon allowable claim 41, claims 45, 46, 47, 48, 49, 50, and 51 depend upon allowable claim 43, claims 53, 55, 56, 57, 58, 59, and 60 depend upon allowable claim 52, claims 62, 63 and 64 depend upon allowable claim 61, and claims 77, 78, 79, 80, and 81 depend upon allowable claim 76, under the doctrine set forth in *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), these dependent claims are also allowable by virtue of the claims dependency upon allowable base claims which are allowable for at least all of the reasons set forth above, and thus the rejections in light of Barton, Wall and Marko et al. have also been overcome.

Conclusion

Applicant respectfully submits that all claim rejections have been overcome and that all pending claims are now in condition for allowance, early notice of which is earnestly solicited.

Respectfully Submitted,

1/03/07

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